

## **REMARKS/ARGUMENTS**

The Office Action of April 21, 2005 has been carefully reviewed and this response addresses the Examiner's concerns stated in the Office Action. All objections and rejections are respectfully traversed.

### **I. STATUS OF THE CLAIMS**

As of this amendment, claims 1-2, 4-19, 21-38, 41-45, 47-56, and 58-71 are currently pending.

Claims 1, 19, and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of United States Patent Application 09/816,693 in view of Kekic et al., United States Patent # 6,664,978, issued on December 16, 2003 (Kekic).

Claim 56 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of United States Patent Application 09/816,693 in view of Kung et al., United States Patent # 6,775,267, issued on August 10, 2004 (Kung).

Claims 68, 69, and 71 are rejected under 35 U.S.C. 112, second paragraph.

Claims 1-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Kekic.

Claims 56-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kekic in view of Kung.

Claims 3, 20, 39, 40, 46, and 57 are cancelled without prejudice.

Claims 1, 2, 4-6, 8-19, 21, 22, 24-34, 36-38, 41-45, 47, 49-54, 56, 58, 60-63, 67-71 are amended herein. Support for the claim amendments can be found, for example, on page 6, lines 1-13, of Applicant's specification. No new matter is added.

### **II. REJECTIONS UNDER JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING**

On pages 2-4, the Office Action states that claims 1, 19, and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of United States Patent Application 09/816,693 ('693) in view of Kekic. On pages 4-5, the Office Action states that claim 56 is rejected under the judicially created

doctrine of obviousness-type double patenting as being unpatentable over claim 1 of '693 in view of Kung.

Applicant has amended claims 1, 19, 31, and 56 to further define the invention. Although Applicant asserts that newly amended claims 1, 19, 31, and 56 are not made obvious by the combination of '693, Kekic, and Kung, Applicant herein files a terminal disclaimer under 37 U.S.C. § 1.321.

***Terminal Disclaimer under 37 U.S.C. § 1.321***

Applicant hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of any patent granted on Application No. 09/816,693, filed on March 22, 2001, as shortened by any terminal disclaimer. Applicant hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the above-listed application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

Because of the terminal disclaimer filed herein, Applicant asserts that the rejection of amended independent claims 1, 19, 31, and 56 (and dependent claims 2, 4-18, 20-30, 32-38, 41-44, 68, 69, and 71) under the judicially created doctrine of obviousness-type double patenting has been overcome.

Applicant provides below arguments to further Applicant's position with respect to the patentability of independent claims 1, 19, 31, and 56 (and dependent claims 2, 4-18, 20-30, 32-38, 41-44, 68, 69, and 71).

**III. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

On page 5, the Office Action states that claims 68, 69, and 71 are rejected under 35 U.S.C. § 112. The Office Action states that those claims recite the limitation "the communicated" with insufficient antecedent basis for the limitation in the claims. Applicant has herein amended these claims to provide proper antecedent bases.

#### IV. REJECTION OF CLAIMS 1-55 UNDER 35 USC § 102(e) AS BEING ANTICIPATED BY KEKIC

Please note that Applicant presents the following arguments, with a few exceptions, in the order in which the claim rejections appear in the Office Action. Applicant has provided headings for the independent claim arguments in order to help Examiner navigate this response.

Applicant respectfully points out that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (CAFC, 1987), M.P.E.P. § 2131. As provided by the remarks set forth below, clearly this is not the case with the present rejection of the claims. In summary, Kekic does not anticipate Applicant's invention because:

- (1) Kekic does not disclose, expressly or inherently, measuring or tracking the amount of processing performed by said gateway (claims 1, 19, 31, and 45) ;  
and
- (2) Kekic does not disclose, expressly or inherently, a usage management system communicatively coupled to said at least one gateway, wherein said at least one gateway is operable to communicate the measured said amount of processing performed to said usage management system (claims 1, 19, and 45).

#### ***Independent claims 1, 19, 31, and 45***

Applicant has amended independent claims 1, 19, 31, and 45 to further define the present invention.

Note that dependent claims 2, 4-18 and 68 depend, directly or indirectly, on independent claim 1, dependent claims 20-30 and 69 depend on independent claim 19, dependent claims 32-38, 41-44, and 70 depend on independent claim 31, and dependent claims 46-55 and 71 depend on independent claim 45.

The Office Action states, on pages 6, 9, and 14, that, as per claim 1 (page 6), (and 19, 31, and 45 (page 9)) (1) Kekic discloses said at least one gateway maintaining usage information detailing the amount of usage of said gateway in managing said one or more

network elements (page 6), and that (2) Kekic teaches polling a network element every 300 seconds, and that this polling would be a gateway maintaining usage information detailing the amount of usage of the gateway because a request is sent to the element every 300 seconds so every 300 seconds the gateway is being used (page 14). Applicant does not fully understand the analogy of elements drawn by the Office Action, but assumes that the Office Action is equating the Kekic's manager with Applicant's management system (claim 1) and the Kekic's element manager with Applicant's claimed at least one gateway (claim 1). Applicant asserts that, even if the above assumptions are not correct, Applicant's amended independent claims 1, 19, 31, and 45 are not anticipated by Kekic.

Applicant has amended claims 1, 19, 31, and 45 to clarify that the gateway itself is measuring the amount of processing performed by the gateway. Whereas Kekic states that the element managers monitor and manage computer network behavior such as network throughput, collision rate, and number of duplicate IP packets (Abstract), Applicant claims that the gateway or distributed gateways measure an amount of processing performed by the gateway or distributed gateway. Thus, Kekic monitors computer network behavior external to, but which affects, the element manager, whereas Applicant claims measuring the amount of processing performed by the gateway, i.e. internal to the gateway. Clearly these are two separate, though possibly overlapping, measurements. For example, if the gateway is receiving messages, then processes will be executing within the gateway to perform the required functions. However, processes that have nothing to do with external stimuli to the gateway will also be performed such as, for example, virus scanning.

Applicant respectfully points out that nowhere does Kekic disclose measuring the amount of processing performed by the gateway.

Applicant asserts that amendments to claims 1, 19, 31, and 45 to clarify the following --

- (1) that the at least one gateway measures or tracks processing performed by the at least one gateway (claims 1, 19, 31, and 45),
- (2) that there is a usage management system to which the at least one gateway communicates the measured or tracked amount of processing performed by the at least one gateway (claims 1, 19, and 45),

(3) that there is a management system capable of determining if the at least one gateway is at a pre-selected processing capacity based on the measured amount of processing performed (claim 1) --

strengthen the previously stated case for the patentability of these claims because Kekic does not teach, explicitly or inherently, the recited limitations.

Since Kekic does not anticipate each and every element of Applicant's amended independent claims 1, 31, and 45, from which dependent claims 2, 4-18, 32-38, 41-44, 47-55, 68, and 71 depend, and each and every step of Applicant's amended claim 19, from which claims 21-30 and 69 depend, either expressly or inherently, Applicant's amended claims 1, 19, 31, and 45 (as well as claims 2, 4-18, 21-30, 32-38, 41-44, 47-55, 68, 69, and 71 that depend, either directly or indirectly, therefrom and that further define the invention) are not anticipated by Kekic, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicant asserts that amended claims 1, 19, 31, and 45 (as well as claims 2, 4-18, 21-30, 32-38, 41-44, 47-55, 68, 69, and 71) are now in condition for allowance. Applicant respectfully requests the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to amended claims 1, 19, 31, and 45 (as well as claims 2, 4-18, 21-30, 32-38, 41-44, 47-55, 68, 69, and 71) for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicant's claimed invention is not an obvious extension of the use of Kekic meet Applicant's patentable limitations.

To further Applicant's position of the patentability of rejected claims 2, 4, 6-18, 21-30, 32-38, 41-44, 47-48, and 50-55, Applicant notes the following.

The Office Action states, on pages 6 and 9, with respect to claims 2, 3, 20, 21, 32, 33, 39, 40, 46, 47, and 55, that Kekic discloses wherein said usage includes gateway processing (col. 15, lines 55-67) and wherein said gateway processing includes handling of messages received from said one or more network elements (col. 1, line 63 – col. 2, line 5). Applicant has cancelled claims 3, 20, 39, 40, and 46 and amended claims 2, 21, 32, 33, and 47.

The shortcomings of Kekic with respect to measuring the amount of processing were set forth above and will not be repeated here.

Applicant respectfully points out that, in the passages that are cited with respect to claim 2, Kekic states that the SNMP defines protocols and message formats to enable communication between a management application and a network element. Kekic further

states that element managers are associated with network elements. Kekic even further states the “[T]he manager provides the run-time environment in which the element managers are executed to monitor and manage computer network behavior such as network throughput, collision rate, and number of duplicate IP packets, to name a few” (col. 6, lines 43-47). Kekic further states that “[T]he element manager of this invention is a template that is used by the manager in the server of this invention to manage a computer network element. The element manager includes basic information data that defines core properties of a computer network element, and event management information that is used in managing the computer network element” (col. 8, line 35-41). Although Kekic states in great detail about the information stored in the element manager (see col. 26), nowhere does Kekic disclose, explicitly or inherently, Applicant’s claimed at least one gateway measuring an amount of processing performed that includes amount of message handling. Therefore the rejection of claims 2, 21, 32, 33, 47, and 55 is inappropriate and should be withdrawn.

The Office Action states, on pages 7 and 9, with respect to claims 4 and 48, that Kekic discloses wherein said at least one gateway includes a SNMP gateway responsible for managing one or more SNMP network elements, and wherein said handling of messages includes handling of SNMP messages (col. 1, line 63 – col. 2, line 50). Applicant has amended claims 4 and 48.

Applicant respectfully points out that Kekic states that “SNMP defines the protocols and message formats which are used to communicate between the management application and the computer network element. . . . The SNMP standards define proxy agents that may be used to access management information from a remote device. A common usage of proxy agents is to translate protocols when the remote device does not support SNMP” (col. 2, lines 1-50). Kekic does not disclose Applicant’s claimed gateway that measures an amount of processing performed by the at least one gateway, where the measured amount of processing includes an amount of message handling of SNMP messages, because Kekic’s accessing management information from a remote device and Applicant’s claimed measuring an amount of processing performed are not the same activities and may not produce the same result. Therefore the rejection of claims 4 and 48 is inappropriate and should be withdrawn.

The Office Action states, on pages 7 and 9, with respect to claims 6, 22, 34, 41, and 50, that Kekic discloses wherein said at least one gateway includes code executable to track said amount of usage of said at least one gateway (col. 82, lines 16-25). Applicant has amended claims 6, 22, 34, 41, and 50.

Applicant respectfully points out that Kekic states that a trap daemon can be used to receive unexpected input (versus polled input) from network elements. A trap daemon could be used to, for example, perform processing with respect to the trap, but would be limited to that particular processing. Applicant, on the contrary, claims, in amended claim 6, that at least one gateway includes code executable to track the *amount* of processing performed by the at least one gateway. Kekic does not disclose or suggest this sort of tracking in the trap daemon or elsewhere. Therefore the rejection of claims 6, 22, 34, 41, and 50 is inappropriate and should be withdrawn.

The Office Action states, on pages 7 and 9, with respect to claims 7-10, 23-25, and 35-38 that Kekic discloses wherein said code includes code implemented within an API (col. 82, lines 16-25). Applicant has amended claims 8-10, 24-25, and 36-38.

Applicant respectfully points out that Kekic states that “[N]ative code is used to call the API functions to get the PDU of a received trap from the trap daemon” (col. 82, lines 19-21). The shortcomings of Kekic with respect to Applicant’s claimed code executable to track said measured amount of processing performed by at least one gateway have been set forth above and will not be repeated here. Applicant respectfully points out that Kekic states the purpose of the cited API functions: to get the PDU of a received trap. Applicant claims code executable to track said measured amount of processing performed by said at least one gateway, where the code is implemented within an API. Kekic does not disclose, explicitly or inherently, that the cited API could perform tracking the amount of processing performed. Therefore the rejection of claims 7-10, 23-25, and 35-38 is inappropriate and should be withdrawn.

The Office Action states, on pages 8-10, with respect to claims 11-13, 26-28, 42-43, and 51-53 that Kekic discloses wherein said at least one gateway includes code executable to track said amount of different types of usage of said at least one gateway (FIGs. 4-37, Abstract). Applicant has amended claims 11-13, 26-28, and 51-53.

The shortcomings of Kekic with respect to measuring or tracking the amount of processing performed by the gateway have been discussed and will not be repeated here.

Applicant respectfully points out that Kekic states that “[T]he manager provides the run-time environment in which element managers are executed to monitor and manage computer network behavior such as network throughput, collision rate, and number of duplicate IP packets, to name a few” (Abstract). The result of monitoring network throughput could be a count of the number of packets that traverse the network over a certain period of time. The result of monitoring collision rate could be a count of the number of packets involved in a collision in the network. The result of monitoring the number of duplicate packets could be a count of the number of duplicate packets that traversed the network. On the contrary, the result of tracking the amounts of different types of processing of said at least one gateway could be a count of the number of messages handled by the gateway and a count of the number of virus scans performed by the gateway. Kekic’s element manager, therefore, monitors and manages computer network behavior, but nowhere does Kekic disclose, either explicitly or inherently, tracking amounts of different types of processing of the gateway (Applicant’s claim 11). Therefore the rejection of claims 11-13, 26-28, 42-43, and 51-53 is inappropriate and should be withdrawn.

The Office Action states, on pages 8 and 10, with respect to claims 14, 29, and 54, that Kekic discloses wherein said usage management system is operable to poll said at least one gateway for said usage information (col. 7, lines 19-30 and col. 46, lines 58-64). Applicant has amended claims 14, 29, and 54.

The shortcomings of Kekic with respect to the lack of a usage management system have been discussed and will not be repeated here. Applicant respectfully points out that Kekic states that “[T]he event engine in the manager of this invention, in one embodiment, is an event rule engine. The event engine process all polling events, and all trap events for the managed computer network element associated with the managed element object” (col. 7, lines 19-21). Kekic also states that “polling events are proactive requests made by management station 110 to elicit information from the agent” (col. 4, lines 19-21). Kekic even further states that “[E]ach of agent processes 121, 131, 141, and 151 monitors and controls the operation of the computer network element containing the agent process” (col. 2, lines 29-32). Thus, Kekic polls agents that are contained in network elements. Applicant, on the contrary, claims a usage management system operable to poll *said at least one gateway*. Applicant, further claims that *said at least one*



gateway is communicatively coupled with one or more network elements. Kekic teaches away from polling a gateway because Kekic states that polling is conducted on the network element itself. Therefore the rejection of claims 14, 29, and 54 is inappropriate and should be withdrawn.

The Office Action states, on pages 8 and 10, with respect to claims 15, 16, and 44, that Kekic discloses wherein said usage management system is operable to compile received usage information into a file (col. 16, lines 15-67). Applicant has amended claims 15, 16, and 44.

The shortcomings of Kekic with respect to the lack of a usage management system have been discussed and will not be repeated here. Applicant respectfully points out that Kekic states, with respect to files, that “[T]he startup file contains a list of managed computer network elements on network 300 and an address on the network of each managed computer network element” (col. 16, lines 35-38). The list of network elements in Kekic’s startup file does not provide a teaching that anticipates Applicant’s claimed usage management system operable to compile said measured amount of processing performed into a file (amended claim 15). Therefore the rejection of claims 15, 16, and 44 is inappropriate and should be withdrawn.

The Office Action states, on pages 8 and 10, with respect to claims 17 and 30, that Kekic discloses wherein said usage management system is operable to electronically communicate said file comprising usage information to a recipient (col. 17, lines 1-40).

The shortcomings of Kekic with respect to the lack of a usage management system have been discussed and will not be repeated here. Applicant respectfully points out that Kekic states that “[W]hen poll server 417 receives a response to polling event, the data in the response is passed to event engine 418 for evaluation” (col. 17, lines 38-40). As previously presented, polling is conducted upon a network element, which is patentably different from Applicant’s claimed polling a gateway. Thus, Kekic’s passing data to an event engine from a poll server is passing data received from a network element to a recipient, the event engine, whereas Applicant claims electronically communicating a file (that contains information from polling a gateway) to a recipient. Therefore the rejection of claims 17 and 30 is inappropriate and should be withdrawn.

The Office Action states, on page 9, with respect to claim 18, that Kekic discloses wherein said usage management system is operable to electronically communicate said usage information received from said at least one gateway to a recipient (FIG. 37).

The shortcomings of Kekic with respect to the absence of a usage management system and the absence of measuring or tracking the amount of processing performed by a gateway have been discussed and will not be repeated here. Applicant respectfully points out that Kekic presents screens to enter information with respect to the element manager, MIB files, hotspots, polling, and traps in FIGs. 37A-M, but Kekic's screens do not disclose electronically communicating the measured amount of processing performed from the gateway to a recipient. Therefore the rejection of claim 18 is inappropriate and should be withdrawn.

#### V. REJECTION OF CLAIMS 56-71 UNDER 35 USC § 103(A) AS BEING OVER KEKIC IN VIEW OF KUNG

The Office Action states, on pages 10-13, that claims 56-71 are rejected as being unpatentable over Kekic in view of Kung. Applicant has amended claims 56, 58, 60-63, 67-71. Applicant has cancelled claim 57 without prejudice.

In order for a rejection under 35 U.S.C. § 103 to be sustained, the Office Action must establish a *prima facie* case of obviousness and to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, and the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The comments in Section IV, distinguishing the present invention over Kekic, also apply here, where appropriate, and will not be repeated.

The Office Action states, on pages 10-11, with respect to claims 56 and 68-71, that Kekic teaches a method for providing to a customer at least one gateway for use in managing one or more network elements (Abstract, col. 7, lines 10-55), and a gateway to track the amount of usage (FIG. 37G). The shortcomings of Kekic with respect to providing a gateway and tracking the amount of processing performed have been set forth above and will not be repeated.

The Office Action states, on page 11, that Kekic does not explicitly teach wherein said customer is charged a fee that is based at least in part on the amount of usage of said at least one gateway and billing said customer based at least in part on the amount of usage of said at least one gateway.

The Office Action states, on page 10, that Kung teaches wherein said customer is charged a fee that is based at least in part on the amount of usage of said at least one gateway (Abstract) and billing said customer based at least in part on the amount of usage of said at least one gateway (FIG. 7C, col. 5, lines 44-63, and col. 4, lines 14-23).

Applicant respectfully points out that Kung states that “[A] variable bit rate communication to be billed has a variable quality of service related to the degree of utilization of a plurality of different networks” (Abstract). Thus Kung states that the variable quality of service is related to the degree of utilization of a plurality of different networks, but the billing rate does not depend on an amount of processing performed by a gateway. Applicant, on the contrary, claims (amended claim 56) calculating a fee based on the amount of processing performed by at least one gateway on behalf of the customer. Therefore the rejection of claims 56 and 68-71 is inappropriate and should be withdrawn.

Since Kekic and Kung, either separately or in combination, do not make obvious each and every step of Applicant’s amended independent claim 56, and Applicant’s dependent claims 68-71, Applicant’s amended independent claim 56 (and dependent claims 58-67 which depend, directly or indirectly, from independent claim 56), and Applicant’s dependent claims 68-71 are not made obvious by Kekic and Kung, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicant asserts that amended independent claim 56 (and dependent claims 58-67 which depend, directly or indirectly, from independent claim 56) and dependent claims 68-71 are now in condition for allowance. Applicant respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to amended independent claim 56 (and dependent claims 58-67 which depend, directly or indirectly, from independent claim 56) and dependent claims 68-71 for the reasons set forth above.

The Office Action states, on pages 12-13, with respect to claims 58-67, reasons for rejection based on Kekic (col. 1, line 63 – col. 2, line 5; col. 82, lines 16-25; FIG. 37, Abstract, col. 16, lines 15-67; col. 7, lines 19-30, col. 46, lines 58-64; and col. 17, lines 1-

40). Applicant has set forth the shortcomings of Kekic with respect to these citations and will not repeat them here. Therefore the rejection of claims 58-67 is inappropriate and should be withdrawn.

## VI. CONCLUSION

In view of the fact that '693 has been overcome by the terminal disclaimer filed herein, Applicant respectfully urges that '693 and Kekic are not sufficient to render the presently claimed invention unpatentable under the judicially created doctrine of obviousness-type double patenting. Further, in view of the absence of Applicant's claimed invention in the Kekic reference as set forth above, Applicant respectfully urges that Kekic is not sufficient to render the presently claimed invention anticipated under 35 U.S.C. 102(e). Still further, Applicant respectfully urges that, as presented above, Kekic and Kung, separately or in combination, are not sufficient to render the presently claimed invention unpatentable under 35 U.S.C. 103(a).

Independent claims 1, 19, 31, and 56 (and dependent claims 2, 4-18, 21-30, 32-38, 41-44, 58-69, and 71) are believed to be in condition for allowance in view of the terminal disclaimer filed herein. Further, independent claims 1, 19, 31, 45, and 56 are believed to be in condition for allowance in view of the deficiencies in Kekic and Kung. All dependent claims depend upon allowable independent claims, and are therefore believed to also be in condition for allowance.

Applicant respectfully requests that this amendment be entered since it places the application in form for immediate allowance or, in the alternative, in condition for appeal.

The Commissioner for Patents is authorized to charge the fee for \$130.00 in payment for the terminal disclaimer filing, as well as any additional fees, or to credit overpayment, to Deposit Account No. 50-1078.


The following information is presented in the event that a call may be deemed desirable by the Examiner:

JERRY COHEN (617) 854-4000

Respectfully submitted,  
Robert Gary, Applicant

Date: June 21, 2005

By:

  
\_\_\_\_\_  
Jerry Cohen  
Reg. No. 20,522  
Attorney for Applicant